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CHARLES W. CALKINS  
KILPATRICK STOCKTON LLP  
1001 WEST FOURTH STREET  
WINSTON-SALEM NC 27101-2410

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JUL 11 2005

**OFFICE OF PETITIONS**

In re Application of	:	
Mjalli, et al.	:	
Application No. 10/611,741	:	DECISION
Filing Date: 1 July, 2003	:	
Attorney Docket No.: 41305.287124	:	

This is a decision on the petition filed on 11 April, 2005, under 37 C.F.R. §1.183, and considered more appropriately as a petition under 37 C.F.R. §1.47.

For the reasons set forth below, the petition:

- under 37 C.F.R. §1.183 is **DISMISSED**, and
- as considered under 37 C.F.R. §1.47 is **DISMISSED**.

**NOTES:**

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.47."
- (2) Thereafter, there will be no further reconsideration of this matter.

## BACKGROUND

The record reflects that:

- Petitioner alleges that one of the named inventors now is deceased and seeks waiver of the statutory and regulatory requirements to proceed with the prosecution without the appropriate review of the application and signing of the oath/declaration;
- Petitioner further alleges that a copy of a death certificate has been submitted, but no such document appears as part of the record at this writing.

## ANALYSIS

Having failed to file a properly executed oath/declaration, Petitioner contends that the Office should waive not only the Rules of Practice but statute as well (35 U.S.C. §§115 - 117) under 37 C.F.R. §1.183<sup>1</sup> and allow Petitioner to prosecute the instant application without satisfying the requirements of a signed oath/declaration.

As one registered to practice before the Office, Petitioner is familiar with the above-referenced statutes and the commentary at MPEP §409,01, et seq.:

### 409.01 Death of Inventor

Unless a power of attorney is coupled with an interest (i.e., an attorney is assignee or part-assignee), the death of the inventor (or one of the joint inventors) terminates the power of attorney given by the deceased inventor. A new power from the heirs, administrators, executors, or assignees is necessary if the deceased inventor is the sole inventor or all powers of attorney in the application have been terminated (but see MPEP § 409.01(f)). See also 37 C.F.R. §1.422.

### 409.01(a) Prosecution by Administrator or Executor

#### **35 U.S.C. 117. Death or incapacity of inventor**

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

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<sup>1</sup> The regulations at 37 C.F.R. §1.183 provide, in pertinent part:

#### **§1.183 Suspension of the Rules.**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. \* \* \*

**37 C.F.R. §1.42. When the inventor is dead.**

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

One who has reason to believe that he or she will be appointed legal representative of a deceased inventor may apply for a patent as legal representative in accordance with 37 C.F.R. 1.42.

Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and the estate was under the sum required by state law for the appointment of an administrator. The heirs should identify themselves as the legal representative of the deceased inventor in the oath or declaration submitted pursuant to 37 C.F.R. 1.63 and 1.64.

**409.01(b) Proof of Authority of Administrator or Executor**

The Office no longer requires proof of authority of the legal representative of a deceased or incapacitated inventor. Although the Office does not require proof of authority to be filed, any person acting as a legal representative of a deceased or incapacitated inventor should ensure that he or she is properly acting in such a capacity.

Petitioner's failure to act in compliance with statute(s) and regulation(s) creates no "extraordinary situation" requiring the invocation of the interests of justice.

The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay.<sup>2</sup>

Moreover, the Office has no authority to waive the statutory requirements.

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<sup>2</sup> See, Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975). Thus, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of the time period set forth in 37 C.F.R. 1.193(b). See, Nitto Chem. Indus. Co. v. Corner, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from petitioner's failure to exercise due care, or lack of knowledge of or failure to properly apply the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc., 195 USPQ 586, 588 (Comm'r Pats. 1977).

Thus, Petitioner seeks a waiver pursuant to 37 C.F.R. §1.183<sup>3</sup> that is neither justified nor permitted.

Accordingly, the petition under 37 C.F.R. §1.183 is **dismissed**.

Thus, Petitioner has made no satisfactory showing in support of a petition under 37 C.F.R. §1.47.

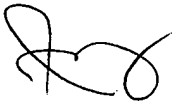
Accordingly, the petition as considered under 37 C.F.R. §1.47 is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
By FAX: IFW Formal Filings  
(703) 872-9306  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>3</sup> Delay resulting from the inadvertence or mistake of Petitioner does not warrant equitable tolling of the time period of 37 C.F.R. §1.193(b). Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983); Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Even assuming *arguendo*, that clerical inadvertence or error caused or contributed to the delay in filing the Reply Brief, such is not a ground for requesting waiver of the regulations. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994).